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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91202493
Party	Plaintiff Ate My Heart Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Application
Serial No. 77/949,907 for the mark BABY GAGA

-----X	:	
ATE MY HEART INC.,	:	
	:	
Opposer,	:	
	:	Opposition No. 91202493
-against-	:	
	:	
ADAM SWAN,	:	
	:	
Applicant.	:	
-----X	:	

**OPPOSER’S REPLY MEMORANDUM OF LAW IN
FURTHER SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT**

Opposer, Opposer Ate My Heart Inc. (hereinafter “AMH” or “Opposer”) respectfully submits this Reply Memorandum of Law in further support of its motion for summary judgment to sustain the opposition brought against Applicant Adam Swan’s (“Applicant”) registration of the mark BABY GAGA (the “Mark”).

PRELIMINARY STATEMENT

This case is ripe for summary judgment. Applicant was unable to identify any issues of material fact which would overcome AMH’s motion. To the contrary, in its opposition brief, Applicant did not challenge – and in fact ignored – all but one of the *Du Pont* factors and each and every one of the undisputed material facts requiring summary judgment for AMH. It is well settled that “[t]he nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial.” *Octocom Systems Inc. v. Houston Computer Services Inc.*, 16 USPQ2d 1783, 1786 (Fed.Cir. 1990). [T]o establish the existence of

disputed facts requiring trial, the nonmoving party ‘must point to an evidentiary conflict created on the record at least by a counterstatement of facts set forth in detail in an affidavit by a knowledgeable affiant.’” *Id.* Applicant has failed to meet this burden.

Applicant failed to address, let alone refute by affidavit or argument, any of the material facts at issue in this proceeding including that:

- (1) Lady Gaga is famous and her name world renown.
- (2) AMH owns trademark registrations in Class 25 for the mark LADY GAGA®.
- (3) AMH has priority of right as to Applicant by virtue of its prior use of the LADY GAGA® mark in commerce.
- (4) AMH has continuously used the LADY GAGA® mark in commerce on apparel since the date set forth in its registration.
- (5) AMH’s Class 25 registration for LADY GAGA® covers a variety of apparel items.
- (6) Applicant’s Class 25 Application covers a variety of apparel items.
- (7) There are no restrictions as to channels of trade in the identification of goods in AMH’s LADY GAGA® registration or in Applicant’s BABY GAGA application.
- (8) There are no restrictions as to targeted consumer base in the identification of goods in AMH’s LADY GAGA® registration or in Applicant’s BABY GAGA application.
- (9) A comparison of the word marks – LADY GAGA and BABY GAGA – reveals that the marks themselves are confusingly similar.

Accordingly, these facts should be deemed conceded, entitling AMH to summary judgment as a matter of law. *See Venture Out Properties LLC v. Wynn Resort Holdings LLC*, 81 USPQ2d 1887, 1890 (TTAB 2007) (granting a motion for summary judgment based in part upon the “absence of any contravening evidence from applicant”).

The only *Du Pont* factor that Applicant attempts to challenge is the similarity of the parties’

goods. In doing so, however, Applicant disregards well-established case law unequivocally holding that when, as here, there are no restrictions in a party's registration or application, it is presumed that the party's goods will be marketed to all relevant consumers for those goods. Thus, as a matter of law, the parties' goods are identical.

Applicant also alleges that because Lady Gaga's name was inspired by the title of a song by the band Queen, she somehow has "unclean hands." This argument is just plain wrong. First, it is axiomatic that AMH's alleged infringement of a different trademark does not furnish grounds for an unclean hands defense. Second, the title of a musical composition is not copyrightable, therefore, Lady Gaga could not have violated Queen's copyright.

Applicant's last argument – that Lady Gaga is so famous that somehow "gaga" has become a generic term - illustrates Applicant's misunderstanding of the principle of genericness. A generic term is the common name for a product or service in connection with which it is used, such as "jeans" when used in connection with denim pants or "salt" when used in connection with sodium chloride. Neither LADY GAGA® nor GAGA is generic for any goods or services, least of all apparel items, the goods at issue here.

These are the incontrovertible facts: AMH famously uses its LADY GAGA® mark on apparel and Applicant intends to use a confusingly similar mark on the exact same items. Given these facts and Applicant's failure to introduce any evidence challenging these facts, AMH's motion for summary judgment should be granted in its entirety.

ARGUMENT

I. As A Matter Of Law, The Parties' Actual Use Is Irrelevant

Applicant does not dispute that Applicant intends to offer apparel items under the mark BABY GAGA. Applicant also does not dispute that AMH sells apparel items under its LADY

GAGA® trademark. Thus, the parties' marks are legally identical such that no genuine issue of material fact is present.

Applicant's attempts to mitigate the identical nature of the parties goods by claiming that its goods will be "baby clothing"¹ utterly misses the point and runs afoul of the well-settled principle of law – set forth in greater detail in AMH's moving papers – that the analysis of the similarity of the parties' goods is confined to the four corners of their respective applications and registrations. *See Octocom Sys., Inc. v. Houston Computers Svs, Inc.*, 918 F.2d 937, 942 (Fed. Cir. 1990). To that end, alleged differences in the design of Applicant's goods, the manner in which Applicant may market and sell them, and the class of purchasers targeted by Applicant cannot be considered unless they are inherent in the nature of the goods themselves or are expressly set forth in the application. *See Gilmar S.p.A. v. Mizuno Kabushiki Kaisha*, 2008 WL 4572607 at *4 (TTAB Oct. 10, 2008) ("Applicant ineffectively focuses its arguments on the sports-related goods in its identification and does not address the identical goods, without any limitation, listed in its identification of goods. The fact that applicant's actual use is limited is not a factor in our decision, which is solely concerned with the four corners of the application and the rights to be accorded it by registration on the Principal Register."); *Squirtco v. Tomy Corp.*, 697 F.2d 1038 (Fed Cir. 1983) ("There is no specific limitation and nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations in to the registration.").

Clearly, there are no limitations in either AMH'S Class 25 LADY GAGA® trademark registrations and use-based application or Applicant's Class 25 BABY GAGA Application and, as

¹ Significantly, there is only one item in Applicant's application that is identified as being "child related." The rest of the items are not so limited. Nevertheless, AMH's Class 25 registration (Reg. No. 3695129) for the mark LADY GAGA® clearly identifies "children" as a target group of its apparel items. Thus, even assuming that Applicant intended to limit his goods to children, his goods would clearly be marketed to the same consumers as AMH's goods.

evidenced by the following chart, almost all of the goods identified in Applicant’s BABY GAGA application are contained in AMH’s trademark registrations and use-based trademark application for LADY GAGA:²

Applicant’s BABY GAGA application	AMH’s LADY GAGA® marks
Hats; Headbands; Infant and toddler one piece clothing; Jackets; Pants; Shirts; Shoes; Sweaters; T-shirts	<p>(Reg. No. 3695129): Clothing for women, men and <u>children</u>, namely, <u>t-shirts</u>, sweatshirts, pullovers, tank tops, vests, shorts and dresses; fashion accessories, namely, <u>hats</u>, <u>headbands</u>, wristbands, scarves and bandanas</p> <p>(Reg. No. 3960468): Clothing, namely, tank tops, t-shirts, <u>jackets</u>, hooded sweatshirts; <u>headwear</u></p> <p>(Use-based App Ser. No. 85115004): Santa hats; masquerade costumes; masquerade costumes and masks sold therewith; Halloween costumes; Halloween costumes and masks sold therewith; clothing including undergarments, board shorts, <u>hot pants</u>, <u>crop shirts</u>, wrap around hoods; gloves; <u>shirts</u>, <u>t-shirts</u>, tank tops, <u>hooded jackets</u>, hooded sweatshirts; <u>headwear</u>, <u>hats</u>, raglans.</p>

To the extent that the goods listed in the respective descriptions are the same (which obviously is the case here), it is presumed that the parties’ goods will be sold in the same channels of trade and to the same relevant purchasers. *See NYS Dept of Economic Devel. V. Ramapo Valley Brewery, Inc.*, 2010 WL 985321 (TTAB Mar. 10, 2010) (“[B]ecause there are no restrictions or limitations in applicant’s description of goods, we must presume that applicant’s [goods] are sold through all normal channels of trade for those goods and that they are available to all types of consumers, including [opposer’s] channels of trade and classes of consumers.”); *In re Smith and Mehaffey*, 31 U.S.P.Q.2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers.”).

² Were Applicant’s Application to register, Applicant would be granted a registration that carries no restrictions as to

Simply stated, because Applicant's proposed goods are of the same type as those previously and sold by AMH under its famous LADY GAGA® Trademarks, the potential for confusion is high. *See Banff Ltd. v. Federated Dep't Stores*, 841 F.2d 486, 492 (2d Cir. 1988) (holding that if the products are similar, the possibility of a likelihood of confusion increases). There is no genuine issue of material fact here.

II. The Parties' Marks are Confusingly Similar

Ignoring the *DuPont* factors, Applicant argues that comparing the two marks "side-by-side" is not the "correct test" to determine whether a likelihood of confusion exists and suggests that a decision in this case can only be reached after Applicant begins to use the mark in commerce. This analysis is fundamentally flawed and it must be rejected.

Despite Applicant's assertions, Opposer never argued that one must evaluate the parties' marks in a side-by-side comparison. However, whether the marks are compared side-by-side or evaluated under the required standard – i.e., whether the marks are sufficiently similar in terms of their overall commercial impression such that confusion as to the source of the goods offered under the respective marks is likely to occur – the result is the same: the marks are confusingly similar.

Significantly, the more similar the goods at issue, the less similar the marks need to be for the Board to find a likelihood of confusion. *See Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874 (Fed. Cir. 1992). Here, the goods are exactly the same so less similarities between the marks are required before a likelihood of confusion finding can result. But the marks at issue are nearly identical. The marks look and sound alike, of course because they contain the exact same suffix and the prefixes differ by a mere two letters. The marks also share the same connotation, courtesy of the fact that the prefixes of the parties' respective marks describe a type of

consumer base or channels of trade and Applicant could decide to use its Mark to directly compete with AMH.

person (“baby” and “lady”). Thus, when the marks are compared in their entireties as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them³, it is clear that confusion is likely. *See In re Gateway Foods*, 2012 TTAB LEXIS 383 at *10 (Oct. 2012) (finding AL COURA and EL KOURA look alike in that “both include a space, and differ by only two letters” and ruling that “[t]he similarity between the marks weighs in favor of a finding of a likelihood of confusion.”).

Applicant suggests that we should consider whether confusion is likely once Applicant commences use of the mark. Applicant’s actual use of its alleged mark is irrelevant.⁴ In fact, because there are no limitations in the filings at issue here, Applicant could alter its channels of trade or target consumer base at will to compete with AMH. Applicant could also modify any designs or stylizations to mimic AMH’s because the marks in both the subject application and in Opposer’s registrations and applications are in “standard character” form, *i.e.*, “without claim to any particular font style, size, or color.” Trademark Rule 2.52(a). *See Cunningham v. Laser Golf Corp.*, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000) (“Registrations with typed drawings are not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in commerce”); *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585, 1588 (TTAB 1992) (“In evaluating likelihood of confusion based on a typed registration, one must consider “all reasonable manners” in which the mark could be depicted.”). Applicant’s actual intended use, therefore, cannot be considered.

³ See test articulated in *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d 1689, 1960 (Fed. Cir. 2005), *quoting In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567.

⁴ Applicant’s civil court cases are inapposite given the numerous differences between registrability cases before the TTAB and infringement cases tried in civil courts. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, (Fed. Cir. 2000) (“Proceedings before the Board are concerned with registrability and not use of a mark. Accordingly, the identification of goods/services statement in the registration, not the goods/services actually used by the registrant frames the issue.”).

III. Applicant's Allegation Of Unclean Hands Fails

Applicant attempts to create a material issue of fact where there is not one by claiming that because Lady Gaga's name was inspired by the title of a song by the band Queen, she somehow has "unclean hands." This argument is desperate, incorrect and frivolous.

First, it is axiomatic that song titles are not copyrightable. *See* 37 C.F.R § 202.1(a). But even assuming AMH's conduct rose to the level of copyright infringement, the law is clear: Opposer's alleged infringement that is not related to this proceeding does not furnish grounds for an unclean hands defense. *See, e.g., 1-800 Contacts, Inc. v. Memorial Eye, P.A.*, 100 USPQ 2d 1151 (D. Utah 2010) (finding that unclean hands defense must be based upon plaintiff's conduct regarding marks plaintiff uses for infringement in its complaint and holding that the alleged conduct of plaintiff engaging in the same (allegedly infringing) conduct that it sued defendant for is conduct unrelated to plaintiff's infringement claim); *Flow Control Indus. Inc. v. AMHI Inc.*, 278 F. Supp. 2d 1193 (W.D. Wash 2003) (No unclean hands found because the trademark owner's alleged infringement of a mark of the accused infringer has nothing to do with the alleged infringement which is the subject matter of the litigation).

Applicant's civil court cases to the contrary are inapposite largely because – unlike the instant opposition – the unclean hands defense asserted in these cases related to the subject matter of the lawsuit. However Applicant's cases, which do not involve trademarks, are also easily distinguishable on their facts. For example, Applicant relies heavily on *Dollar Systems v. Avcar Leasing Systems*, 890 F.2d 165, 173 (9th Cir. 1989), where the plaintiff sued the defendant for negligent breach of contract and the defendant asserted the doctrine of unclean hands as a defense. In finding that the unclean hands defense did not apply, the court noted that the defendant failed to show that the plaintiff had bad intent. Applicant here failed to show it as well. Lady Gaga's

alteration of “Radio ga-ga” - a phrase that is not subject to trademark or copyright protection - is legally permissible. As such, there can be no “bad intent” by Lady Gaga or AMH.

Another of Applicant’s cases actually supports AMH’s position. In *Belaval v. Rio Grand Community Health Center*, 488 F.3d 11 (1st Cir. 2007), the court found that the doctrine of unclean hands did not apply where the alleged bad conduct (operating medical facilities without a valid contract with a landlord) was not directly related to the merits of the controversy between the parties (an action against the state for a failure to reimburse Medicare expenses). Here, Lady Gaga’s supposed copyright infringement does not go to the merits of the current controversy - whether the Applicant’s proposed mark would cause a likelihood of confusion with AMH’s federally registered trademark. As such, much like in the *Belaval* case, the doctrine of unclean hands does not apply.

IV. Applicant’s Mark is not Generic for Apparel Items

Applicant’s argument that Lady Gaga is so famous that somehow “gaga” has become a generic term is based on a complete misunderstanding of the principle of genericism. A generic term is “[t]he name of a product or service itself – what it is” 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 12:1 at 12-4. Obviously, the term “gaga” has not become the common name for a product or service in connection with which it is used, such as “clothes” or “jeans.” Therefore, it is not, by definition, generic. It is certainly not generic of apparel items.

Applicant does admit, however, that Lady Gaga is so famous that all things GAGA connote Lady Gaga. Clearly then, the mark LADY GAGA®, as a strong and famous mark, is entitled to a wide latitude of legal protection. Indeed, the fame of the LADY GAGA® mark increases the likelihood that consumers will believe that Applicant’s Mark is in some way affiliated with AMH. *See Kenner Parker Toys, Inc.*, 963 F.2d at 353 (“The fame of a trademark may affect the likelihood purchasers will be confused inasmuch as less care may be taken in purchasing a product under a

famous name.”); *See Recot, Inc. v. Becton*, 54 U.S.P.Q.2d 1894, 1898 (Fed. Cir. 2000) (holding that famous marks deserve more protection because they are more likely to be remembered and associated in the minds of a consumer and thus the fame of a mark is a “dominant factor in the likelihood of confusion analysis.”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 23 U.S.P.Q.2d 1698, 1701 (Fed. Cir. 1992) (holding that the “fame of CENTURY 21 increases the likelihood of confusion with applicant’s mark [CENTURY LIFE OF AMERICA]”).

As a junior user, Applicant had the responsibility to ensure that its mark did not infringe a prior user. Applicant did the exact opposite – it chose a mark that is virtually identical to a famous trademark and intends to use its mark on the same goods sold by AMH. These facts are undisputable. Accordingly, summary judgment must be granted.

CONCLUSION

For the reasons discussed above and in AMH’s initial moving papers, AMH’s motion for summary judgment refusing registration of the Applicant’s Mark should be granted.

Dated: October 29, 2012

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I hereby certify that a true and correct copy of Opposer's Reply Memorandum being sent by electronic mail addressed to the following counsel for Applicant, on October 29, 2012:

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I hereby certify that on October 29, 2012, this correspondence was filed electronically by ESTTA.

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